

Appln No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

2

REMARKS/ARGUMENTS

INTRODUCTION

The applicant is in receipt of the Office Action Summary and Detailed Action mailed December 2, 2003. The applicant notes that the only pending rejections are based on 35 USC 103(a).

ARGUEMENTS

Introduction

The examiner objects to the claims under 35 USC 103(a). The applicant seeks reconsideration. At the onset of these arguments, the applicant wishes to summarize for the examiner the basis on which reconsideration is sought. In short, it is the applicant's contention that the examiner has allowed bias and hindsight to dominate the reporting process. The examiner has clearly worked backwards from a fixed opinion and has reconstructed, in hindsight, inventive motives which never existed before the applicant's specification was filed and has arbitrarily combined structures in ways never before contemplated. The examiner has placed himself in the position of gatekeeper and has invented rules for rejection which in conflict with the most widely accepted legal principles of examination. The applicant wishes to avoid appeal.

The examiner must acknowledge his role as neutral observer and not critic of invention. This stems from the well known Constitutional mandate, reproduced here for reconsideration:

The Constitution of the United States provides:

"Art. 1, Sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

There are two further points worthy of mention in the summary. First, the examiner has not met his burden on the establishment of a *prima facie* case. Second, the entire analysis performed by the examiner is fraught with doubt, particularly as to the highly technical mechanical combinations suggest only by the examiner. As to any technical,

Appln No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

3

scientific or legal doubts, these should be resolved in favor of the applicant and yet, have not.

Examiner's Burden Not Met

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be **some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art, and not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The examiner has taken enormous liberty in combining references. First, nowhere in the prior art is there and suggestion that such a combination is remotely possible or desirable. No motive is provided for the combination, apart from the applicant's specification.

Appln No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

4

The examiner has used the "analogous arts" rubric to justify an elaborate reconstruction of the art for a single purpose, to reject the claims. However, there is no such rubric or rule which permits the examiner to combine art in such abandon of accepted principles.

To support a rejection under 35 U.S.C. 103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, applicant's claimed invention would have been obvious. In applying this test to the claims on appeal in *Ochiai* and *Brouwer*, the court held that there simply was no suggestion or motivation in the prior art. Consequently, the court overturned the rejections based upon 35 U.S.C. 103. See, *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) In both cases, the Federal Circuit held that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. 103. Rather, 35 U.S.C. 103 requires a highly fact-dependent analysis involving taking the claimed subject matter as a whole and comparing it to the prior art.

The examiner's proof goes no further than the pictures in the cited references. The texts of the references are of no support to his case. Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured. Therefore, such an enabling picture may be used to reject claims to the article. However, the picture must show all the claimed structural features **and how they are put together**. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928).

The Examiner Relies on Impermissible Hindsight

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole"

Appl No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

5

of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

The law is clear: THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION. There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In *In re Kotzab*, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one *system* may be used to control a

Appln No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

6

number of valves. While the control of multiple valves by a single sensor rather than by multiple sensors was a "technologically simple concept," there was no finding "as to the specific understanding or principle within the knowledge of the skilled artisan" that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

The Examiner's Proposed Combination is Ineffective

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

The applicant's claimed invention specifies:

- an elongate body having a longitudinal axis with a stationary print head housed within said body.
- the body having two opposing slots, the slots being parallel to the longitudinal axis and interconnected by a paper path which passes through the body;
- powered rollers for moving a printable media through the paper path and past said stationary print head;

Appin No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

7

- not true

Kokubo has an elongated body, but the print head is not "within" it. Kokubo prints onto a stationary media. Maeda has powered rollers and opposing slots, but does not disclose any means or motive whatsoever for locating the Maeda style print technology into either a Kokubo type device or an elongated body as claimed by the applicant. The applicant is the first to teach this combination and the first to provide the motivation and no evidence at all exists to the contrary. Why would Kokubo seek to incorporate Maeda? The purpose of Kokubo is to print onto an external medium. Why would Maeda incorporate a scanner like Kokubo? The issue of the combination of the references raises more questions than it answers. There is clearly no motive other than the one provided by the examiner to reject the claims.

That the References Can be Combined is not Helpful to the Examiner's Case

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*,

Appln No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

8

217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

In this case, the applicant denies that the references can be combined in any useful or immediately appreciable way. One is a camera/printer and the other is a scanner/printer. The scanner has the in-built need for a synchronising contact roller and uses it to coordinate the print operation. It has no need for the Maeda style printer. The Maeda style printer is nowhere near compact enough to meet the applicant's stated aims and claim language. Even if Maeda sought to meet the promise of the applicant's claims, it fails to provide the technical teachings required to do so. In this field the applicant was first and there is no evidence to the contrary. The examiner's reconstruction changes the principle of operation of each of the cited references and is impermissible. 270 F.2d at 813, 123 USPQ at 352.).

SUMMARY

In the present case the examiner has not provided any motivation or suggestion for the combinations made in the previous Office Action. The examiner suggests that the references are from analogous arts. This may indicate that references can be physically combined (they can not) but provides no proof or indicator of motivation or suggestion which can be seen as other than hindsight reconstruction. The combination itself is highly dubious and technically unfeasible, changing the operational principles of each cited reference.

The burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. He has not. With all due respect, the examiner has not carried the burden on the issue of obviousness under 35 USC 103. Favorable reconsideration is requested.

Appln No. 09/575,182
Amdt. Dated February 10, 2004
Response to Office action of December 2, 2003

9

Very respectfully,

Applicant:



KIA SILVERBROOK

Applicant:



SIMON ROBERT WALMSLEY

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762